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Paper No. 13

PILLSBURY WINTHROP LLP
1600 Tysons Boulevard
McLean VA 22102

In re Application of
Wang et al.
Application No. 10/052,475
Filed: January 17, 2002
Title of Invention: CHEMICAL MECHANICAL
POLISHING ENDPOINT DETECTION

COPY MAILED

JUL 20 2004

OFFICE OF PETITIONS

DECISION ON PETITIONS
UNDER 37 CFR 1.48 AND 1.183

This is in response to the "Petition For Acceptance Of Application Refusal By Inventor To Join (37 CFR 1.47) filed on April 2, 2004 which is being treated as a petition under 37 CFR 1.48 and 37 CFR 1.183.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR. §1.136(a).

Petitioner seeks to add inventor Efrain Velazquez to the inventive entity. However, Mr Velazquez has failed to execute the declaration and the statement to support the request to change inventorship.

The petition filed under 37 CFR 1.48 is **DISMISSED**.
The petition filed under 37 CFR 1.183 is **DISMISSED**.

Petition Under 37 CFR 1.48

A grantable petition under 37 CFR 1.48 (a) requires: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor and from each person being deleted as an inventor

that the error in inventorship occurred without deceptive intention on his or her part; (3) an oath or declaration by the actual inventor or inventors as required by §1.63 or as permitted by §§ 1.42, 1.43 or §1.47; (4) the processing fee set forth in §1.17(l); and (5) if an assignment has been executed by any of the original named inventors, the written consent of the assignee.

As to item (2) petitioner has failed to provide a written statement from inventor Efrain Velazquez indicating the error in inventorship occurred without deceptive intent.

As to item (3), petitioner has failed to submit an executed oath or declaration which states the entire inventive entity

As to item (5), petitioner has failed to provide the consent of the assignee.

Accordingly, the 37 CFR 1.48 petition can not be granted without the above including an executed oath or declaration or a grantable petition under 37 CFR 1.183.

Petition Under 37 CFR 1.183

The petition filed on April 2, 2004 is being treated under 37 CFR 1.183. Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires."

Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603. This application bears a Declaration executed by five inventors thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

When a petitioner seeks a waiver of the 1.48 statement regarding lack of deceptive intent the requirement that inventor sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a).

Petitioner has failed to submit an executed declaration which lays out the entire inventive entity.

The petition under 37 CFR 1.183 is Dismissed.

Pursuant to petitioner's request deposit account 50-2213 is being charged the \$130.00 petition fee pursuant to 37 CFR1.17(h).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile:

(703) 872-9306
(571) 273-0025 (After September 28, 2004)

By delivery service:
(FedEx, UPS, DHL, etc.)

U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

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Office of Petitions